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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,846	07/24/2001	Takatoshi Nishizawa	210638US0	4818

22850 7590 03/21/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
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EXAMINER
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ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/21/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- ☒ Claim(s) 1-30 is/are pending in the application.
- ☐ Of the above claim(s) 30 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-29 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

**Application Papers**

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 6, 7
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-29, drawn to a label and an accompanying article having the label, classified in Class 428, subclass 349.

II. Claim 30, drawn to a method of labeling, classified in Class 264, subclass 509.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process such as applying it to a preformed product.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Frederick Vastine on March 12, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-29.

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Affirmation of this election must be made by applicant in replying to this Office action. Claim 30 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The Examiner makes the suggestion that applicant's Abstract should be substantially revised, perhaps in the manner similar to that set forth in Serial No. 09/834,968, which corresponds to United States Patent Application Publication 2001/0028952A1 to Nishizawa et al.

7. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 2, and 14-29 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not

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enabling. More particularly, applicant's specification beginning at page 9, line 26 appears to disclose that a very specific genus of antistatic agents appears to be critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

9. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 949559, taken either individually or in view of Janocha et al. The primary reference, of which applicant has a corresponding U.S. patent application 09/287,194 which is believed to be in the process of being issued, discloses (note particularly the Abstract, Figures 1 and 2, page 2 lines 5-9, page 2 line 45 - page 4 line 9, page 4 line 19 - page 6 line 52, page 7 lines 30-31, page 8 lines 6-9, Example 1, claims) a closely related <sup>in-</sup>~~the~~ mold label that comprises a thermoplastic resin film base layer such as polypropylene and can also have

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additional layers laminated on each side thereof, but essentially further requires the presence of a heat sealable resin outer layer comprising a polyethylene, applicant's most preferred antistatic agent polyetheresteramide, a low molecular weight polyethylene and a polyamide resin. The reference does not teach the presence of an interlayer between the thermoplastic resin film base layer and the heat sealable outer resin, but it is noted that interlayers are both known and taught in the reference and also the same thermoplastic resin utilized in applicant's interlayer structure can comprise the thermoplastic resin film base layer material. Additionally, the reference does not teach the presence of antistatic agents such as polyetheresteramides in the interlayer composition but such a structure is believed to be both within the ordinary skill of the art, as well as specifically ~~taught~~ <sup>hinted at</sup> in the related structure of the secondary reference Janocha et al., ~~which discloses~~ (note particularly column 5 lines 36-38, column 5 lines 46-53, Examples 1-3, claim 1) which further teaches ~~that~~ <sup>of in-mold labels</sup> that the core layer or other top or bottom layers can contain "customary additives such as antistatic agents", thereby leading to the clear inference that the specific location of components such as antistatic agents and also modified low molecular weight polyethylenes, polyamide resins and the like are all a mere design choice for one of ordinary skill in the art. With respect

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to the dependent claims, the great number of embodiments set forth therein have been taught by the prior art submitted by applicant and including such elements as the presence of an ionomer, a metal salt, polyethylene resins having a certain degree of crystallinity, and the presence of inorganic powders and fillers, are each taught as variables well within the ordinary skill of the art. Additionally, EP '599 also discloses quite a few of these components which are set forth in the dependent claims. Other parameters that are not either expressly or inherently disclosed are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Patent Application Publication 2001/0028952A1 to Nishizawa et al., cited above and Wade et al.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

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reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

March 19, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900  
1700

*Daniel Zinker*